UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,762	07/07/2003	Matthew Eden	DC-05125	8009

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HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER
RAYMOND, EDWARD

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 September 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-8 and 18-20</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>9-12</u> is/are rejected.

7)☒ Claim(s) <u>13-18</u> is/are objected to.

8)☒ Claim(s) <u>1-20</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20030925</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   **Claims 1-8**, drawn to a system for testing information handling systems, classified in class 702, subclass 121.

    II.   **Claims 9-17**, drawn to a method for performing runtime tests on test information handling, classified in class 702, subclass 121.

    III.   **Claims 18-20**, drawn to a test information handling system, classified in class 702, subclass 121.

The inventions are distinct, each from the other because of the following reasons:

2.   Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of testing information handling systems has separate utility such as a fault detection system without the use of a database. See MPEP § 806.05(d).

3.   Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of testing information handling systems has separate utility such as a fault detection system without the use of a network interface. See MPEP § 806.05(d).

4.   Because these inventions are distinct for the reasons given above and the

search required for Group I is not required for Group II, restriction for examination

purposes as indicated is proper.

5.   Because these inventions are distinct for the reasons given above and the

search required for Group I is not required for Group III, restriction for examination

purposes as indicated is proper.

6.   During a telephone conversation with on September 26, 2004 a provisional

election was made without traverse to prosecute the invention of Group II, claims 9-17.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-8 and 18-20 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   **Claims 9-12** are rejected under 35 U.S.C. 102(b) as being anticipated by Weiner

et al. Weiner et al. teach a method for performing runtime tests on test information

handling systems (Claim 9: see paragraph 21), the method comprising: sending an

execute identifier from a test server to one or more test units (Claim 9: see Figure 41:

Unit test 1-n and Figure 32), the execute identifier associated with a script package

having plural scripts (Claim 9: see paragraph 20: The Examiner notes that the

application comprises a plurality of scripts); responding to the execute identifier from the

test unit to the test server with a test-unit profile (Claim 9: see paragraphs 126-141+:

The Examiner notes that a profile is created from an existing library); generating at the

test server one or more test executables and runtimes to execute one or more scripts of

the script package by applying the test unit profile to one or more test engines (Claim 9:

see paragraph 46: The Examiner notes that the patching engine is equivalent to a test

engine); sending the test executables and runtime from the test server to the test unit

(Claim 9: see Figure 41: ProbeRunner); and executing the test executable and runtime

on the test unit (Claim 9: see paragraph 160 through paragraph 168).

Weiner et al. teach a method further comprising communicating between the test

server and the test units with an intermediate remote test controller (Claim 10: see

Figure 30: ProbeRunner Controller).

Weirner et al. teach a method further comprising: tracking results of the test

executable on the test unit (Claim 11: see Figure 31 and also Figure 41: Test

Respository Defect Tracking Database); and periodically communicating the results to

the test server (Claim 11: see paragraph 46).

Weirner et al. teach a method wherein generating at the test server one or more

executables and runtimes further comprises: selecting a script by comparing the test

unit profile with script parameters (Claim 12: see paragraph 164 through paragraph

167); and generating a runtime for executing the script with a one of plural test engines,

the test engine associated with the script (Claim 12: see paragraph 21).

Allowable Subject Matter

9.   **Claims 13-17** are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Mackey et al. teach a terminal server simulated client

performance measurement tool. Boucher teaches a method and system for testing

memory operations of computer program. Takahashi teaches a method, apparatus,

and program for constructing an execution environment, and computer readable

medium recording program thereof. Christie teaches a process for performance testing

computer equipment accessible via a telecommunications network. Laviolette et al.

teach a software test system and method.

Contact Information

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Edward Raymond whose telephone number is 571-272-

2221. The examiner can normally be reached on Monday through alternating Friday

between 8:00 AM and 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone numbers for

the organization where this application or proceeding is assigned are 571-273-2221 for

regular communications and 571-272-1562 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1782.

September 29, 2004
Edward Raymond
Patent Examiner
Art Unit 2857